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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,864	04/27/2001	Martin M. Matzuk	P01925US2 (09807797)	1363

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EXAMINER

WILDER, CYNTHIA B

ART UNIT	PAPER NUMBER
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1637

11

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/844,864

Applicant(s)

MATZUK ET AL.

Examiner

Cynthia B. Wilder, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-26 is/are pending in the application.
- 4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 is/are allowed.
- 6) ☒ Claim(s) 23,24 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |                                                                                              |                                                                             |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### FINAL ACTION

1. The final action mailed 7/30/2003 in Paper No. 10 is being withdrawn in lieu of this Final Action to address the error made by the Examiner in the prior Office Action concerning newly submitted claims 23-26.

2. Applicant's amendment filed in Paper No. 9 is acknowledged. Claims 1-18 has been canceled. Claims 19-26 have been added. The newly submitted claims have been thoroughly reviewed. However, the newly submitted claims 19-22 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly submitted claims 19-22 are drawn to a an isolated polynucleotide having the polynucleotide sequence set forth in Fig. 5 (SEQ ID NO: 5), a fragment or a derivative thereof. The newly submitted claims 19-22 are patentably distinct from the previously examined claim 2 in that the previously examined claim 2 was drawn to an isolated polynucleotide having the polynucleotide sequence set forth in Figure 1 (SEQ ID NO: 16). A review of the specification has revealed that SEQ ID NO: 5 nor the polynucleotide sequence depicted in Figure 5 is related to or is identical to the polynucleotide sequence depicted in Figure 1 or the sequence of SEQ ID NO: 16. Therefore, the newly submitted claims 19-22 have a different inventive entity from the previously examined claim 2 and require a different field of search.

3. Since Applicant has received an action on the merit for the originally present invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly claims 19-22 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP 821.03. Claims 23-26 are pending in the instant application.

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*New Ground(s) of Rejections*

**APPLICANTS' AMENDMENTS NECESSITATE THE NEW GROUND(S) OF REJECTIONS:**

***Claim Rejections - 35 USC § 102(b)***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim is 23 rejected under 35 U.S.C. 102(b) as being anticipated by Burglin et al. (Genes Dev., 1987). Regarding claim 23, Burglin et al. teach a sequence comprising a fragment or derivative of SEQ ID NO: 16 (see Fig 3 and attached sequence alignment). Therefore, Burglin et al. meets all of the limitations of claim 23.

***Claim Rejections - 35 USC § 102(e)***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 24 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Fu et al. (US 6090620, filing date December 1996). Regarding claims 24 and 26, Fu et al. teach a sequence comprising a sequence that is complementary to the polynucleotide sequence of claim 23 and a sequence which is capable of hybridizing to fragment of the polynucleotide sequence of claim 23 (see SEQ ID NO: 209, col. 3, lines 19-32 and attached sequence alignment). Therefore, Fu et al. meets the limitation of claims 24 and 26 of the instant invention.

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*Conclusion*

6. Claims 23, 24 and 26 are rejected. Claim 25 contain allowable subject matter. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia B. Wilder, Ph.D. whose telephone number is (703) 305-1680. The examiner can normally be reached on Monday through Thursday from 9:30 am to 6:30 pm and Friday from 9:30 am to 1:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0196.

Cynthia B. Wilder, Ph.D.  
Examiner  
Art Unit 1637

cbw  
August 25, 2003

*Handwritten signature: Han Berger*  
*SPK*